

REMARKS

Prior to entry of this Amendment and Response, claims 2-10 and 12-42 are pending in the application. This paper cancels no claims. Accordingly, claims 2-10 and 12-42 remain pending after entry of the amendments herein.

1. Objection to Claim 28

The Examiner objected to claim 28 as employing the term "reusable," insofar as the term renders claim terminology inconsistent. In response thereto, the Applicant has removed the word "reusable" from the claim. The Applicant thus requests the Examiner withdraw his objection to claim 28.

2. Objection to the Specification

The Examiner objected to the specification, alleging new matter was added by the amendment filed July 6, 2004. In response thereto, the Applicant has removed the objected-to sentence from the specification.

3. Rejections Under 35 U.S.C. § 112- Claims 41 and 42

The Examiner rejected claims 41 and 42 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner alleged these claims recited a contamination prevention means "adapted to isolate [a] light source from [a] lumen," which allegedly was not supported by the original disclosure filed.

In response to the Examiner's rejection, the Applicant has amended claim 41 to require "an observation window adapted to isolate the light source from the lumen," rather than a contamination prevention means. As mentioned by the Examiner in the Office action, the isolation of light source from lumen is "accounted for by the window (14) in the embodiment shown in Figure 2" (Office action, page 4, first paragraph). Thus, the Applicant respectfully submits the present amendment is fully supported by the specification as filed, and therefore satisfies the written description requirement.

Next, the Examiner objected to claim 42 as being inconsistent with the disclosure, insofar as the contamination prevention means allegedly does not include a gas-tight window. To address the Examiner's rejection, the Applicant has amended claim 42 to require the observation window form at least part of the connection means. The Applicant respectfully submits this amendment overcomes the Examiner's § 112 rejection.

For the foregoing reasons, the Applicant respectfully requests the Examiner withdraw his rejections and allow claims 41 and 42, as amended.

4. Rejections Under 35 U.S.C. § 112- Claims 2, 18-20 and 28-40

The Examiner rejected claims 2, 18-20 and 28-40 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to distinctly claim the subject matter regarded by the Applicant as the invention. More particularly, the Examiner alleged claims 2 and 18-20 depend from previously-canceled claim 43, while claims 28-40 are indefinite for referring to a single element of a previous claim in the preamble. In response to the first rejection, the Applicant has amended claim 2 to depend from claim 42, and claims 18-20 to depend from claim 41 in place of claim 43. Further, the Applicant has amended claims 28-40 to recite a “sigmoidoscope” instead of a “speculum” in their preambles, thus responding to the second rejection.

The Examiner also rejected claim 38, alleging the claim required a “hollow tubular body” separate from the “substantially rigid tube” required by parent claim 41. The Applicant has amended claim 38 to claim the tube (initially recited in claim 41) has light transmission properties. The Applicant believes this amendment adequately addresses the Examiner’s rejection.

The Applicant thus respectfully submits claims 2, 18-20 and 28-40 have been amended to address the concerns raised by the Examiner. For at least the foregoing reasons, the Applicant respectfully requests the Examiner withdraw his rejections and allows these claims.

5. Rejections Under 35 U.S.C. § 103- Fiore and Sugiyama

The Examiner rejected claims 2, 3, 5-8, 10, 12-24, 28, 30, 31 and 33-42 under 35 U.S.C. § 103(a) as unpatentable over the combination of United States Patent No. 3,889,661 to Fiore in view of Japanese Publication No. 06-319691 to Sugiyama. The Examiner alleged Fiore discloses the claimed invention, with the exception of a contamination prevention means. The Examiner further alleged Sugiyama teaches a contamination prevention means, and that one of ordinary skill in the art would be motivated to combine Fiore and Sugiyama to produce the claimed invention.

The Examiner noted, however, that this rejection is predicated on “interpreting the contamination means as defined by the original specification.” The Applicant respectfully submits amended independent claim 41, from which all the other rejected claims directly or indirectly depend, now requires “an observation window adapted to isolate the light source from the lumen.” The Applicant respectfully submits Fiore fails to teach such an observation window. Rather, Fiore’s optical lens 33 is located at a proximal end of the disclosed device, while the light source (lamps 25, as defined by the Examiner) are isolated from the lumen by the combination of a cylindrical section 18 and a flange 19 (col. 4, lines 8-12). Accordingly,

Fiore does not teach or suggest an observation window that also isolates a light source from a lumen.

Further, amended claim 41 now requires an "insufflation medium... conveyed directly from the insufflation means to the lumen by a gas conveying insufflation tube without contacting a light head housing the light source." The Applicant respectfully submits Fiore fails to teach an insufflation medium conveyed without contacting a light head housing a light source.

Fiore generally teaches "...both suction and pressure is applied [to insufflate the colon] through a nipple or conduit 34 which projects from lighting head 21 [sic] and communicates to the interior of barrel 11 through an appropriate opening or slot 35 (not shown) in cylindrical section 18" (col. 6, line 67, to col. 7, line 3). As shown in phantom in Fig. 1, the fluid passage of the insufflation medium (conduit 34) passes directly through lighting head 24. (The Applicant respectfully submits the quoted portion misstates the element number of the lighting head as "21," which is the element number assigned to the obturator tip.)

Accordingly, the insufflation medium is pumped through the conduit 34, which passes through the lighting head 21. Thus, the insufflation medium must contact the lighting head 21, even though the light sources (lamps 25) may not be contacted.

By contrast, independent claim 41 requires the insufflation medium not contact the light head housing the light source. Since Fiore teaches exactly the opposite the Applicant respectfully submits the reference, either alone or in combination with Sugiyama, cannot anticipate or render obvious the invention of independent claim 41.

The Applicant respectfully submits the amendment to claim 41, reciting a light head, is supported by the disclosure as filed. The Applicant respectfully refers the Examiner to the sentence beginning on page 17, line 15, which reads as follows: "In the embodiments of the invention described with reference to figures 2-14 disposable speculum 1 is adapted for connection with a fibre optic head 5 whereby a light source 8 may be connected with the sigmoidoscope." Support for the present "light head" is provided by reference to the fibre optic head 5, disclosed in this paragraph.

For at least the foregoing reasons, the Applicant respectfully submits claim 41 is patentable over the cited references. Accordingly, the Applicant respectfully requests the Examiner withdraw his rejections and allow claim 41.

The remaining claims depend, either directly or indirectly, from independent claim 41. Accordingly, these claims are also patentable. The Applicant makes this statement without reference to the independent bases of patentability contained within each claim. The

Applicant therefore requests the Examiner withdraw his rejections and allow the dependent claims over the references of record.

6. Rejections Under 35 U.S.C. § 103- Fiore, Sugiyama, and Shiels

The Examiner rejected claims 9 and 32 under 35 U.S.C. §103(a) as unpatentable over the aforementioned combination of Fiore and Sugiyama, further in view of United States Patent No. 5,061,239 to Shiels. For at least the following reason, the Applicant respectfully disagrees.

The Applicant has shown claim 41 to be patentable over the cited references, alone or in combination. Claims 9 and 32 depend from claim 41, and are therefore also patentable. The Applicant makes this statement without reference to the independent bases of patentability contained within each claim. Accordingly, the Applicant respectfully requests the Examiner withdraw his rejection and allow the claims.

7. Rejections Under 35 U.S.C. § 103- Fiore and Shiels

The Examiner rejected claims 4, 6, 8, 9, 29 and 32 under 35 U.S.C. § 103(a) as unpatentable over the combination of Fiore and Shiels. For at least the following reason, the Applicant respectfully disagrees.

The Applicant has shown claim 41 to be patentable over the cited references, alone or in combination. Claims 4, 6, 8, 9, 29 and 32 depend from claim 41, and are therefore also patentable. The Applicant makes this statement without reference to the independent bases of patentability contained within each claim. Accordingly, the Applicant respectfully requests the Examiner withdraw his rejection and allow the claims.

8. Allowable Subject Matter

The Applicant thanks the Examiner for determining that claims 25-27 would be allowable if rewritten in independent form, including all the limitations of the base claim and any intervening claims. In light of the amendments to claim 41 and the above remarks, the Applicant has declined to rewrite any of these claims in independent form. The Applicant reserves the right, however, to rewrite these claims in independent form at a later date.

5. Conclusion

The Applicant thanks the Examiner for his careful review of the application, and believes the foregoing remarks and amendments place the application in condition for allowance. Issuance of a Notice of Allowability is respectfully requested.

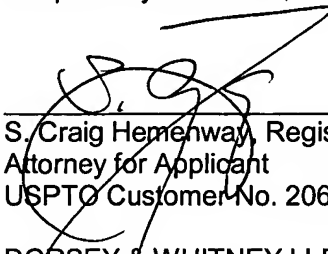
This paper is submitted contemporaneously with a petition for a two-month extension of time and payment of the associated fee. The Applicant believes no additional fees or

petitions are due with this filing. However, should any such fees or petitions be required, please consider this a request therefor and authorization to charge Deposit Account No. 04-1415 as necessary.

If the Examiner should require any additional information or amendment, please contact the undersigned at (303) 352-1124.

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Respectfully submitted,



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